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| APPLICATION NO.   | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
| 10/747,682  | 12/30/2003    | Roy Ben-Yoseph       | 06975-541001/ Security 30 | 3174             |
| 26171   | 7590          | 03/18/2009           | EXAMINER                  |                  |
| FISH & RICHARDSON P.C.<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |               |                      | TAHA, SHAQ                |                  |
| ART UNIT  | PAPER NUMBER  |                      |                           |                  |
|   | 2446          |                      |                           |                  |
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| 03/18/2009  | ELECTRONIC    |                      |                           |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

|                              |                                      |  |
|------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/747,682 | <b>Applicant(s)</b><br>BEN-YOSEPH, ROY |
|                              | <b>Examiner</b><br>SHAQ TAHA         | <b>Art Unit</b><br>2446                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11/19/2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1- 45, 47, and 49 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1- 45, 47, and 49 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12/30/2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11/19/2008

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

This is a final action for application number 10/747,682 based on after non-final filed on 11/19/2008. The original application was filed on 12/30/2003. Claims 1 – 45, 47, and 49 are currently pending and have been considered below. Claims 46 and 48 have been canceled. Claims 1, 9, 15, 17, 18, 22, 23, 31, 37, 39, 40, 45, 47, and 49 are amended.

**Response to Arguments**

Applicant's arguments with respect to claims 1 – 45, 47, and 49have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims and 1 – 8, 23 – 30, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Daniell et al. et al. (US 2004/0054735).

Regarding claim 1 & 23 & 45, Friskel teaches a method of providing online presence information: maintaining a list of people that is known to a user, [FIG. 6 illustrates an example of the contents of approved contacts file 116, which is the list of other members of messaging system 100 that have been selected by the sender using sender computer 106 as being approved contacts eligible to receive status information about the sender, wherein the contact list is maintained as shown in Fig. 1, Ref # 116, (Friskel et al., Col. 6, lines 28 - 35)],

accessing the maintained list of people determined to be known to a user, [Approved contacts file 116 is visible to the sender, but other information regarding such members is not accessible by the sender as shown in Fig. 1, Ref # 110 and 112 wherein a client contact list is shown, (Friskel et al., Col. 3, lines 56 – 60)],

accessing online presence information for the user, [Hidden contacts file 112 contains a list of messaging system members received from server 102 including the status information for each listed member as provided by server 102 as shown in Fig. 4, Ref # 114, (Friskel et al., Col. 4, lines 25 – 29)],

determining a potential receiver of the online presence information, [Hidden contacts file 112 corresponds to that portion of the members of messaging

**system 100 that have given the user of client computer 104 permission to receive their on-line status information as shown in Fig. 4 wherein the client as a potential receiver of the online presence of the contacts, (Friskel et al., Col. 3, lines 29 – 33)],**

comparing the potential receiver to the accessed list to determine if the potential receiver is included on the list, **[Visible contacts file 110 contains a list of aliases for those members of messaging system 100 that have been selected by the client user as being approved contacts eligible to receive status information about the client user as shown in Fig. 4, wherein the approved contact list has a potential receiver that is included on the list, (Friskel et al., Col. 3, lines 37 – 41)],**

and determining whether to communicate the online presence information to the potential receiver based on whether the potential receiver is included in the list, **[Approved contacts file 116 is stored on sender computer 106 and contains a list of aliases for members for which the sender using sender computer 106 has given permission to obtain on-line status information about the sender as shown in Fig. 5 wherein the approved contacts list and to communicate the online presence to the contact list, (Friskel et al., Col. 3, lines 50 – 55)],**

Friskel et al. fails to teach determining that a person is known to the user based, at least in part, on one or more communications between the person and the user and adding the person to the maintained list,

Daniell et al. teaches the address book user interface 404 permits a user to add new contact information and edit presently existing contact information, wherein the person is known to the user based on communications as shown in Fig. 11 Ref # 1130

and 1135, (**Daniell et al., Paragraph 99**), and upon logging into each of the user's email accounts, the email user agent 106 retrieves all of the email messages stored on the email accounts and stores them at a local mail store as shown in Fig. 8, wherein the user receives and e-mail and stores the person on the list, (**Daniell et al., Paragraph 53**), in order to retrieve internet presence information of the user's contacts, (**Daniell et al., Paragraph 64**).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Friskel et al. by determining that a person is known to the user based, at least in part, on one or more communications between the person and the user and adding the person to the maintained list, (**Daniell et al., Paragraph 99**), in order to retrieve internet presence information of the user's contacts, (**Daniell et al., Paragraph 64**).

Regarding claim 2 & 24, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining to not communicate the online presence information to the potential receiver when the potential receiver is not included in the list, [Fig. 4, is receiver is not on list, online presence won't be communicated].

Regarding claims 3 & 25, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to an

instant messaging application of the potential receiver, [Fig. 1, Ref # 108, wherein an E-mail server is equivalent to instant messaging].

Regarding claims 4 & 26, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information on a web page, [Fig. 3 shows an inbox which is a part of a webpage].

Regarding claims 5 & 27, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in member search results, [Fig. 3, Ref # 304, wherein the search result is in the inbox].

Regarding claims 6 & 28, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in a member profile, [Fig. 4, Ref # 114].

Regarding claims 7 & 29, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver when a request for online presence information is received from the

potential receiver, [Fig. 1, arrows 118 correspond to communication between client computer 104 and server 102 for requesting and providing member information for hidden contacts file 112].

Regarding claims 8 & 30, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver absent a request from the potential receiver for the online presence information, [Fig. 4, Ref #114 wherein online status is available without request].

Claims and 9 – 22, 31 – 44, and 47 - 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Dieterman et al. (US 6,393,464).

Regarding claim 9, 15, 16, 20, 21, 31, 37, 38, 42, and 43, The modified Friskel et al. teaches determining that a person is known to the user based, at least in part, on one or more communications between the person and the user,

Friskel et al. fails to teach determining that the person is know to the user based on positive user actions related to e-mail communications from the person,

Daniell et al. teaches the address book user interface 404 permits a user to add new contact information and edit presently existing contact information, wherein the

person is known to the user based on communications as shown in Fig. 11 Ref # 1130 and 1135, (**Daniell et al., Paragraph 99**), and upon logging into each of the user's email accounts, the email user agent 106 retrieves all of the email messages stored on the email accounts and stores them at a local mail store as shown in Fig. 8, wherein the user receives and e-mail and stores the person on the list, (**Daniell et al., Paragraph 53**), in order to retrieve internet presence information of the user's contacts, (**Daniell et al., Paragraph 64**).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the modified Friskel et al. by determining that the person is know to the user based on positive user actions related to e-mail communications from the person, (**Daniell et al., Paragraph 53**), in order to retrieve internet presence information of the user's contacts, (**Daniell et al., Paragraph 64**).

Regarding claim 10 & 32, Friskel teaches the method wherein the positive actions include sending an E-mail to the person, [**Figure 1, Ref # 108**].

Regarding claims 11 & 33, Friskel et al. discloses the method wherein the positive actions include replying to, forwarding, saving, or printing e-mail received from the person, [**Fig. 3, Ref # 312**].

Regarding claim 12 & 34, Friskel teaches the method wherein the positive actions include moving an e-mail from a first folder to a second folder, [Fig. 3, Ref # 312, 314].

Regarding claim 13 & 35, Friskel teaches the method wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, [Fig. 3, Ref # 312, 314].

Regarding claim 14 & 36, Friskel teaches the method wherein the positive action includes leaving an e-mail from the person open for a predetermined period of time, [Fig. 7, Ref # 706].

Regarding claim 18 & 40, Friskel teaches that the method determining that a person is known to the user based, at least in part, on one or more communications between the person and the user includes detecting user actions that mitigate against factors that otherwise are used to infer a person is known to the user, [Fig 6, Ref # 116].

Regarding claim 19 & 41, Friskel teaches the method wherein the user actions comprise the user taking steps to report a communication from the person as spam, [Fig. 5, Ref # 110].

Regarding claim 17, 39, 47, and 49, the method wherein determining that a person is known to the user based, at least in part, on one or more communications between the person and the user further comprising inferring that a person is known to the user, wherein inferring comprises: accessing a contact list of the user to determine a first contact on the user's contact list, **[Fig. 4 shows a contact list wherein Sue is the first contact],**

and accessing a contact list of the first contact to determine a second contact on the first contact's contact list, **[Fig. 4 shows a contact list wherein Sue is the first contact and Sue has her own contact list].**

Regarding claim 22, 44, the method determining that a person is known to the user based, at least in part, on one or more communications between the person and the user further comprising: enabling the user to expressly designate a person as known to the user, **[Fig. 4 shows an approved list of contacts that are designated as known to the user],**

and adding the designated person to the list, **[Fig. 4 shows an added person to the list of contacts that are designated as known to the user].**

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaq Taha whose telephone number is 571-270-1921. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Put can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Application/Control Number: 10/747,682  
Art Unit: 2446

Page 12

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

/S. T./

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446